



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,502	09/03/2004	Eberhard Ammermann	53325	2835

26474 7590 04/19/2006

NOVAK DRUCE DELUCA & QUIGG, LLP  
1300 EYE STREET NW  
SUITE 400 EAST TOWER  
WASHINGTON, DC 20005

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/506,502	<b>Applicant(s)</b> AMMERMANN ET AL.	
	<b>Examiner</b> Alton N. Pryor	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-6 and 9 is/are allowed.
- 6) ☐ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

- I. Applicant's arguments, see paper, filed 1/17/06, with respect to the rejection(s) of claim(s) 1,3,5-9 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.
- II. Rejection of claims under 35 USC 103(a) will not be maintained in light of amendment filed 1/17/06. Applicant shows unexpected results for mixtures in claims 1-6,9. Therefore claims 1-6,9 are free of the art. However, with respect to claim 7 there exist no written description in the specification for synergism when compounds I and II, III or IV are applied separately or successively. See 35 USC 112, 1<sup>st</sup> paragraph rejection below. Claim 7 was examined with the inclusion of "the compound of formula I". See suggestion below. Claim 8 appears to comprise the application of a mixture or compounds; however, application of compounds have no antecedent basis. See 35 USC 112, 2nd paragraph rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "or the compound of the formula I and at least one compound of the formula II, III, or IV" in lines 2-3. There is insufficient antecedent basis

Art Unit: 1616

for this limitation in the claim. Claim 1 from which claim 8 indirectly depends is to a mixture. However, claim 8 uses both a mixture and compounds. There exist antecedent basis for the mixture in claim 1, but there exist no antecedent basis for applying compound(s) in claim 1.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

To satisfy the written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that application was in possession of the claimed invention. The specification recites on pages 2-3 that applying compounds I and II, III or IV simultaneously, i.e. separately, or applying compounds I and II, III or IV in succession provides "better control". The specification on page 5 recites compounds I and II, III or IV used separately exhibit "outstanding activity". The phrases "better control" and "outstanding activity" do not indicate "synergy". The specification does not provide a written description of synergism where the compounds I and II, III or IV are applied separately or successively. The

Art Unit: 1616

specification on pages 2,7,10-12 provides written description for synergistic mixtures (compositions) comprising compounds I and II, III or IV.

Claim 7 employing applying compounds I and II, III or IV simultaneously, i.e. separately, or applying compounds I and II in succession are neither described nor exemplified and the specification does not inform the public of the limits of the monopoly asserted.

To satisfy the written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that application was in possession of the claimed invention. There is no description in the specification for applying compounds I and II, III or IV simultaneously, i.e. separately, or applying compounds I and II in succession to obtain synergism as recited in claim 7.

#### ***Allowable Subject Matter***

Claims 1-6,9 are allowable. Applicant provides unexpected (synergistic) data for mixtures (compositions) comprising compounds I and II, III or IV in claims 1-6,9.

#### ***Suggestion***

Claim 7 should be amended to recite "formula I" after the 2<sup>nd</sup> occurrence of "the" in line 2.

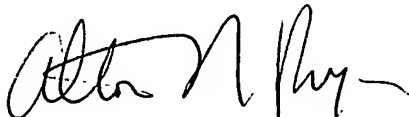
#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a horizontal line extending from the end of the signature.

Alton Pryor  
Primary Examiner  
AU 1616